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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,579	07/18/2000	SERGEY A. SELIFONOV	02-028950US	8517

22434 7590 09/30/2002

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EXAMINER

ZHOU, SHUBO

ART UNIT PAPER NUMBER

1631

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>	
	09/618,579	SELIFONOV ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shubo "Joe" Zhou	1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 93-98 and 133-156 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 93-98 and 133-156 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### ***Response to CPA and Amendment***

Applicants' request for a Continued Prosecution Application (CPA), filed 7/1/02, under 37 CFR 1.53(d) based on prior patent Application No. 09/618579, is accepted and a CPA has been established.

### ***Restriction/Election Requirement***

Applicants' amendment in Paper #23, filed 7/1/02, introduces new claims 133-156. Currently, claims 93-98 and 133-156 are pending. The claims, however, encompass multiple inventions that are patentably distinct as set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. § 121.

I. Claims 93-98, 133-138, drawn to a method of producing recombinant polypeptides by a combination of computer assisted and laboratory procedures, classified in Class 435, subclass 91.1.

II. Claims 139-147, drawn to a method of identifying a set of oligonucleotides for use in an in vitro recombination procedure by virtually a computational method, classified in 702, subclass 19.

III. Claims 148-156, drawn to a computer program product, classified in Class 700, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are directed to separate and distinct inventions. Group I is directed to a method of producing recombinant polypeptides by a combination of

computer assisted and laboratory procedures, classified in Class 435, subclass 91.1 whereas Group II is directed to a method of identifying a set of oligonucleotides for use in an in vitro recombination procedure by virtually a computational method, classified in 702, subclass 19. The two inventions are classified in different classes and the methods require distinct procedures and produce different products. Group I requires laboratory procedures and produces recombinant molecules physically in the laboratory. Group II, however, is virtually a computational procedure and identifies a set of oligonucleotides *in silico*. Consequently, these inventions have acquired a separate status in the art as a separate subject for inventive effect and are usually published separately. The search for each of the above inventions is not co-extensive particularly with regard to the literature search.

The inventions of Group III and Groups I-II are separate and distinct. As set forth above, Groups I-II are procedures, computational, or in combination with laboratory, to produce or identify nucleic acid. Group III, however, is directed to a computer system, which is classified in a totally different class and has distinct usage. The methods of making nucleic acids and a computer system have certainly acquired a separate status in the art as a separate subject for inventive effect and are usually published separately. The search for each of the above inventions is not co-extensive particularly with regard to the literature search.

Because these inventions are independent/distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

A fully responsive communication will comprise a proper election of a group, and sequences, as well as compliance with the sequence rules (or microfiche guidelines) as set forth above. Examination cannot proceed without a complete response.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

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Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D.

Patent Examiner



MICHAEL BORIN, PH.D.  
PRIMARY EXAMINER

